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In re Application of
Tomlins, et al.
Application No. 09/470,629
Filed: December 22, 1999
Attorney Docket No.: 476-1871
For: COMMUNICATIONS NETWORK

**OFFICE OF PETITIONS
A/C PATENTS**
ON RENEWED PETITION

This is in response to the renewed petition under 37 CFR 1.47(a),
filed December 1, 2000.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)", and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor. Failure
to respond will result in abandonment of the application. Any
extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed December 22, 1999
without an executed oath or declaration and naming Andrew
Geoffrey Tomlins, Simon Daniel Brueckheimer, David John Stacey,
John A. Shotton, Osama Bhagat, and Greg Bernstein as the joint
inventors.

Accordingly, on February 8, 2000, a "Notice to File Missing Parts
of Application" was mailed, requiring an executed oath or
declaration, and a surcharge for its late filing. In response, on
August 10, 2000, a petition under 37 CFR 1.47(a) was filed. This
petition was dismissed September 27, 2000.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof
that the non-signing inventor cannot be reached or refuses to
sign the oath or declaration after having been presented with the
application papers (specification, claims and drawings); (2) an
acceptable oath or declaration in compliance with 35 U.S.C. §§
115 and 116; (3) the petition fee; and (4) a statement of the
last known address of the non-signing inventor.

Petitioner lacks items (1), (2), and (4) set forth above.

As to item (1), the petition lacks sufficient evidence to
establish that the nonsigning inventors cannot be reached, were
ever presented with a copy of the application papers
(specification, claims and drawings), or, having been presented
with the application papers, refuse to sign the oath or
declaration.

Petitioner has included the declaration of John Peter William Ryan. In this declaration, declarant states that co-inventor Tomlins informed him that co-inventors Bhagat and Bernstein were no longer employed by Nortel Networks Harlow Laboratories, partial assignee of the present application. The declaration goes on to state that the Human Resource Centre of the partial assignee has no residential addresses for either nonsigning inventor.

The declaration also asserts that there is a misspelling of one of the inventor's names, namely, "Bhagat" is more correctly spelled "Bahgat¹."

Declarant states that he has searched United Kingdom telephone directories to no avail seeking listings for the nonsigning inventors. No evidence of these searches has been presented to date.

Declarant also states that he has searched for each of the nonsigning inventors through online means, has made telephone calls to nineteen "Greg Bernsteins" and three "Osama Bahgats", all to no avail. Again, no evidence of these efforts has been presented.

Declarant states further that he has made inquiries with the Canadian offices of Nortel Networks, the partial assignee of the instant application, and have not been able to acquire a last known address or point of contact for either nonsigning inventor.

The declaration also states that declarant suspects the nonsigning inventors are currently residing within the United States, yet, the instant renewed petition is not accompanied by evidence of any search efforts conducted throughout the United States.

The petition states the last known address of nonsigning inventor Bhagat is 1420 McDowell Boulevard, North Petaluma, California. However, the petition is not accompanied by any evidence that applicant attempted to contact the nonsigning inventor at this address or provide the nonsigning inventor with a copy of the application papers (specification, claims, and drawings). Dated cover letters and/or mailing receipts as evidence that the nonsigning inventor was presented with a copy of the application papers or having been presented with the application papers, refused to sign the oath or declaration should be provided.

In addition, information regarding attempts to acquire a forwarding address for the nonsigning inventor should accompany any renewed petition.

A recent brief search of the Lexis®.com EZFIND Combined Person Locator Nationwide database revealed the following:

¹ Petitioner is advised that a petition under 37 CFR 1.182 to correct the spelling of the inventor's name is required.

- (1) OSAMA BAHGAT
1420 MCDOWELL BLVD.
PETALUMA, CA 94954
address current as of 5/97
- (2) OSAMA BAHGAT
259 CAMBRIDGE LN.
PETALUMA, CA 94952
address current as of 3/99
previous address listed at (1) above
- (3) OSAMA BAHGAT
20128 PACIFICA DRIVE
CUPERTINO, CA 95014
TELEPHONE NO. 763-9811
address current as of 2/1/01
previous address listed at (2) above

Petitioner is required to undertake additional efforts to acquire a current address of the nonsigning inventor as well as present a copy of the application papers (specification, claims, and drawings) to the nonsigning inventor.

As to nonsigning inventor Bernstein, no persuasive evidence exists in the record that sufficient efforts have been made to locate this person and provide them with a copy of the application papers. Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay, will not normally be accepted. At the very least, a search of telephone directories should be undertaken of the regions where it is suspected the nonsigning inventor may reside. Petitioner may wish to utilize regional, national, or international registries to seek information regarding this inventor. Copies of the results of such searches must be referred to in any renewed petition. See, MPEP 409.03(d).

It is important that the forthcoming communication contain statements of fact as opposed to conclusions. If there is an express oral refusal, a statement from the person to whom that refusal was made should be made of record.

As to item (2), the declaration submitted with the instant petition is not acceptable as it fails to comply with 37 CFR 1.63 and 1.64. The declaration presented with the instant petition does not list the addresses of inventors Bhagat and Bernstein. In addition, the declaration is improperly executed. Specifically, the signature blocks for the nonsigning inventors have been signed by one other than the inventor. Where it is alleged in a petition under 37 CFR 1.47(a) that an inventor cannot be located or refuses to sign the oath or declaration, the remaining inventors should sign the declaration in their own name and on behalf of the nonsigning inventors. Therefore, the signature blocks of the nonsigning inventors should remain unexecuted. Petitioner is advised that any renewed petition should include a

properly executed oath or declaration.

As to item (4), the petition fails to state the last known address of at least one nonsigning inventor. A last known address is required under 37 CFR 1.47(a). If, after diligent efforts have been exerted, such as those discussed above, and a last known address is still not available, applicant may wish to file a petition under 37 CFR 1.183 requesting a suspension of the rule requiring applicant to provide the last known address of the nonsigning inventor.

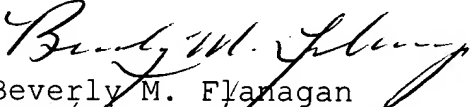
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn.: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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Telephone inquiries related to this decision may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.


Beverly M. Flanagan
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for Patent Examination Policy